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10/018,175	02/14/2002	Jacques Pierre Pouyfaucou	J342-011 US	8503

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NOTARO AND MICHALOS  
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SUITE 110  
ORANGEBURG, NY 10962-2100

EXAMINER

OLTMANS, ANDREW L

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 07/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

10/018,175

Applicant(s)

POUYFAUCON ET AL.

Examiner

Andrew L Oltmans

Art Unit

1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Claim Objections*

1. Claims 2, 3 and 15 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

a. With respect to claims 2 and 3, the claims fail to further limit the parent claim (i.e. claim 1) because claim 1 recites, "applying to the metal articles directly, i.e. without any prior treatment of any kind", while claims 2 and 3 recite treatments contrary to the recitation in claim 1. Therefore, claims 2 and 3 fail to further limit claim 1.

b. With respect to claim 15, the claim recites particular reactivity additives that appear to lack the limitations of the parent claim (i.e. claim 14). Claim 15 does not appear to recite phosphonate or phosphates that are hydrocarbonated, fluorinated or chlorofluorinated. If it is the intention of the applicant to claim the components in claim 15 as being phosphonate or phosphates that are hydrocarbonated, fluorinated or chlorofluorinated, a statement clearly indicating said intention should be made on the record.

2. Claims 7, 11-12 and 15 are objected to because of the following informalities:

a. Claims 7, 11-12 and 15 recite improper alternative language. The claims should utilize proper alternative language, (e.g. Markush groups or the disjunctive "or"), see MPEP 2173.05(h). Appropriate correction is required.

*Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. In claim 1, the phrase, “applying to the metal directly, i.e., without prior treatment of any kind” renders the claim indefinite because the statement is unclear. In view of the specification and particularly claims 2 and 3, it appears that the statement does not limit the claims in the way literally to “without prior treatment”. For example, without prior treatment would indicate that the coating takes place immediately after formation (e.g. casting with no forging or forming treatments). Therefore, the phrase renders the claim indefinite. It is further noted that the term “directly”, does not clearly establish the point at which the surface treatment takes place. For example, is a cleaning allowed prior to coating? Is oil from metalworking permitted to be on the surface? Does a natural oxide on the surface preclude applying “directly”?

b. In claim 1, the transitional phrase “characterized in that it consists in” renders the claim indefinite because the phrase utilizes both open and closed transitional phrases, see MPEP 2111.03. Therefore, the scope of the claim cannot be determined by one of ordinary skill in the art.

Art Unit: 1742

- c. In claims 1, 4-7, and 13 recite the term "it", wherein the antecedent basis of the term "it" is not clear.
- d. In claims 8-10, the term "said additive" does not have a clear antecedent basis. For example, the claim from which claim 8-10 depends (i.e. claim 4), recites various additives, including a corrosion-inhibiting additive and an oligomer additive.
- e. In claims 11-12, the phrase "said monomer compatible with said binder" lacks antecedent basis. For example, the claim from which claim 11-12 depends (i.e. claim 8), recites a "polymer chain compatible with the binder"; however, no mention of a monomer compatible with said binder is made.
- f. Claims dependent upon the above are likewise rejected under this statute.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**NOTE REGARDING CLAIM INTERPRETATION**

As currently recited, the claims recite a coating composition (and method) wherein the coating composition includes a film-forming binder and "at least one corrosion-inhibiting additive reactive with metal and at least one oligomer additive bearing phosphonic acid". The claim

Art Unit: 1742

encompasses phosphonic acid components that are also reactive with metal (i.e. a single compound) or composition encompassing two separate compounds with the claimed functionality. As long as the claimed functionalities are taught, the claim limitations are met. Also, the recitation of the additive being "compatible with the binder" has been interpreted broadly in view of the context of the claims and the specification. Being "compatible" is being interpreted by the examiner to merely mean that the ingredients are able to be present in the same composition.

***Braig et al. 5,980,619***

6. Claims 1, 3-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Braig et al. 5,980,619 (Braig).

Braig teaches a composition for treating metal in order to protect the metal from corrosion and the method for contacting the metal with the composition, wherein the composition includes a film-forming binder (col 13, lines 53-59), a corrosion-inhibiting additive reactive with the metal and at least one oligomer additive bearing phosphonic acids, including the compatible polymer chains, the statistical copolymers, the phosphonated monomers, the methacrylic, acrylic, styrene, vinyl chloride, vinyl fluoride or vinyl ester monomers, the polycondensable monomers, diols or epoxide diacids, and the particular phosphonate or phosphoric additive instantly claimed (col 1, line 66 to col 13, line 31), as recited in claims 1, 4 and 8-15 (see also col 28, lines 1-36). Braig teaches the particular additive components, including the claimed pigments, wetting agents (col 14, lines 44-54 and col 28, lines 1-36), as recited in claims 5-7. Braig teaches that the composition may be degreased as recited in claim 3

Art Unit: 1742

(col 28, line 59) or directly to the substrate (col 15, lines 26-31), as recited in claim 1. The claims do not distinguish over the teachings of Braig.

***Baxter 4,505,748***

7. Claims 1, 4-5 and 8-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Baxter 4,505,748 (Baxter).

Baxter teaches a composition for treating metal in order to protect the metal from corrosion and the method for contacting the metal with the composition, wherein the composition includes a film-forming binder (col 6, lines 46-55), a corrosion-inhibiting additive reactive with the metal and at least one oligomer additive bearing phosphonic acids, including the compatible polymer chains, the statistical copolymers, the phosphonated monomers, the methacrylic, acrylic, styrene, vinyl chloride, vinyl fluoride or vinyl ester monomers, the polycondensable monomers, diols or epoxide diacids, and the particular phosphonate or phosphoric additive instantly claimed (col 2, line 8 to col 5, line 34 and col 5, line 66 to col 6, line 27), as recited in claims 1, 4 and 8-15 (see also col 8, lines 17-40). Baxter teaches the particular additive components, including the claimed pigments (col 7, line 15). Baxter teaches contacting the composition directly on a metal surface, as recited in claim 1 (col 8, lines 51-53). The claims do not distinguish over the teachings of Baxter.

***European Patent Application EP 0 763 574 A2 Omoto et al.***

8. Claims 1, 3-5 and 8-15 are rejected under 35 U.S.C. 102(b) as being anticipated by European Patent Application EP 0 763 574 A2 Omoto et al. (EP '574).

EP '574 teaches a composition for treating metal in order to protect the metal from corrosion and the method for contacting the metal with the composition, wherein the

Art Unit: 1742

composition includes a film-forming binder (page 3, lines 57-59), a corrosion-inhibiting additive reactive with the metal and at least one oligomer additive bearing phosphonic acids, including the compatible polymer chains, the statistical copolymers, the phosphonated monomers, the methacrylic, acrylic, styrene, vinyl chloride, vinyl fluoride or vinyl ester monomers, the polycondensable monomers, diols or epoxide diacids, and the particular phosphonate or phosphoric additive instantly claimed (page 2, line 4 to page 3, line 34), as recited in claims 1, 4 and 8-15 (see also page 8, lines 1-50). EP '574 teaches the particular additive components, including the claimed pigments (page 2, line 35). EP '574 teaches that the composition may be treated as recited in claim 3 (page 4, line 24) or directly to the substrate (page 4, lines 23-25), as recited in claim 1. The claims do not distinguish over the teachings of EP '574.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

***Braig et al. 5,980,619, Baxter 4,505,748 and European Patent Application EP 0 763 574 A2***

***Omoto et al. in view of the ASM Handbook, Volume 13, "Cleaning for Surface Conversion", pages 1-4, 1992***

10. Claim 2 and claim 3 (for Baxter only) is rejected under 35 U.S.C. 103(a) as being unpatentable over Braig et al. 5,980,619 (Braig), Baxter 4,505,748 (Baxter) and European Patent



Art Unit: 1742

Application EP 0 763 574 A2 Omoto et al. (EP '574) in view of the ASM Handbook, Volume 13, "Cleaning for Surface Conversion", pages 1-4, 1992 (ASM Handbook).

Braig, Baxter and EP '574 teach and are applied as set forth above in paragraphs 6-8.

Braig, Baxter and EP '574 fail to meet all the limitations of the instant claims in that **Error! Reference source not found.** does not explicitly teach the coarse brushing and Braig fails to teach the coarse cleaning of surface grease.

The ASM Handbook teaches that brushing and cleaning, as recited in claims 2 and 3 are well-known process steps used in the coating process in order to increase the adhesion of subsequent coating (pages 1-2).

One of ordinary skill in the art at the time that the invention was made would have found the invention to be obvious because one of ordinary skill in the art would have been motivated to provide the well-known process step of cleaning or brushing, as taught in the ASM Handbook, in order to provide Braig, Baxter and EP '574 with the desirable properties of increased adhesion of the coating, as taught in the ASM Handbook.

### *Conclusion*

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew L. Oltmans whose telephone number is 703-308-2594. The examiner can normally be reached 7:00-3:30 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 703-308-1146. The fax phone numbers for the

Art Unit: 1742

organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

A handwritten signature in black ink, appearing to read "Andrew L. Oltmans", is positioned above the printed name and title.

Andrew L. Oltmans

Examiner

Art Unit 1742

July 21, 2003